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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY H. DAILY, JIRI PAZDIREK
and ROBERT G. BUDZYN

Appeal No. 2005-1126
Application No. 09/846,141

ON BRIEF

Before FRANKFORT, MCQUADE and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Timothy H. Daily et al. originally took this appeal from the final rejection of claims 2 through 18 and 22 through 27. As the appellants have since canceled claims 22 through 27, the appeal now involves claims 2 through 18, all of the claims currently pending in the application.

THE INVENTION

The invention relates to "stabilizer bars, such as the stabilizer bars used in automotive suspensions" (specification, page 1). Representative claims 2 and 5 read as follows:

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2. A stabilizer bar comprising:

a fiber-reinforced composite rod comprising a plurality of fibers embedded in a resin binder, said rod comprising first and second rod ends;

first and second metallic arms secured to the respective rod ends;

wherein the composite rod comprises a longitudinal axis, wherein the fibers comprise first, second and third sets of fibers, wherein the fibers of the first set are oriented at $0^\circ \pm 15^\circ$ with respect to the axis, wherein the fibers of the second set are oriented at $+45^\circ \pm 15^\circ$ with respect to the axis, and wherein the fibers of the third set are oriented at $-45^\circ \pm 15^\circ$ with respect to the axis.

5. A stabilizer bar comprising:

a fiber reinforced composite rod having a tubular configuration and including a plurality of fibers embedded in a resin binder, said rod having first and second open ends;

first and second arms, each arm comprising a respective recess, each of said recesses receiving one of said rod ends; and

first and second plugs positioned within the first and second rod ends within the first and second recesses, respectively.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Francois Andersen	3,638,455 4,138,141	Feb. 01, 1972 Feb. 06, 1979
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THE REJECTION

Claims 2 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Francois in view of Andersen.

Attention is directed to the main and reply briefs (Paper Nos. 14 and 18) and answer (Paper No. 15) for the respective positions of the appellants and examiner regarding the merits of this rejection.

DISCUSSION

Francois, the examiner's primary reference, discloses a torsion bar for use in an automobile suspension. The bar comprises a glass filament-wound epoxy resin torsion tube 10 having external splines 12 at each of its end regions 11a, backup reinforcing cylinders or sleeves 16, 16' disposed within the end portions of the tube, and a pair of structural members 13 having internal splines 14 mating with the external splines on the end portions of the tube. The glass filament-wound epoxy resin construction of the tube consists of "continuous filaments in successive plies oriented at equal but opposite angles of about 40° to 50°, preferably about 45°, with respect to the axis of the tube" (column 2, lines 16 through 19).

The examiner concedes (see page 4 in the answer) that Francois does not meet the limitation in independent claim 2, and the corresponding limitation in claim 8 (which depends from

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independent claim 5), requiring the composite rod to comprise fibers oriented at $0^{\circ}\pm 15^{\circ}$ with respect to the longitudinal axis of the rod. The examiner submits, however, that "[t]he particular orientation . . . of the fibers would have been obvious to one of ordinary skill in the art as a mere matter of choice dependent on the desired spring rate" (answer, page 3). Presumably, this conclusion of obviousness encompasses the addition to the Francois torsion rod/tube 10 of fibers oriented at $0^{\circ}\pm 15^{\circ}$ with respect to the longitudinal axis of the rod. The examiner further explains that "anyone of even rudimentary knowledge of forming fiberglass understands that plies are laid successively at different angles so as to increase the strength -- note the suggestion in column 2, lines 15-20 of Francois" (answer, page 4).

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the examiner has not advanced any evidentiary support for the proposition that it would have been

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obvious to modify the Francois tube/rod 10 by the addition of fibers oriented at $0^\circ \pm 15^\circ$ with respect to the longitudinal axis of the rod. The passage from the Francois reference noted by the examiner (which for the most part is reproduced above) lacks any suggestion for this modification and fails to substantiate the examiner's assertions about the spring rate and strength of filament-wound structures.

Since Andersen does not cure the foregoing evidentiary shortcomings of Francois, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 2 and 8, and dependent claims 3, 4, 9 through 11, 14/2, 15/2, 16/2, 17 and 18, as being unpatentable over Francois in view of Andersen.

We also shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 12 and 13, which depend from independent claim 5, as being unpatentable over Francois in view of Andersen.

Claims 12 and 13 respectively recite a stabilizer bar having fibers oriented at $0^\circ \pm 10^\circ$ and $0^\circ \pm 5^\circ$ with respect to the axis of the rod. For the reasons discussed above, the combined teachings of Francois and Andersen would not have rendered this subject matter obvious within the meaning of § 103(a).

We shall sustain, however, the standing 35 U.S.C. § 103(a) rejection of independent claim 5, and dependent claims 6, 7,

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14/5, 15/5 and 16/5, as being unpatentable over Francois in view of Andersen.

The torsion bar disclosed by Francois constitutes a stabilizer bar meeting all of the limitations in claim 5, with the Francois torsion tube 10, structural members 13 and reinforcing cylinders or sleeves 16, 16' respectively embodying a fiber reinforced composite rod, first and second arms and first and second plugs as set forth in the claim. Hence, Francois establishes that the subject matter recited in claim 5 lacks novelty.¹ Lack of novelty is, of course, the ultimate or epitome of obviousness. In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

Dependent claims 6, 7, 14/5, 15/5 and 16/5 fall with parent claim 5 since the examiner has not challenged the rejection thereof with any reasonable specificity (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Finally, because the reasoning underlying our action in sustaining the rejection of claims 5 through 7, 14/5, 15/5 and 16/5 differs significantly from that advanced by the examiner in support of the rejection, we hereby designate our action in this

¹ Consequently, the examiner's application of Andersen in combination with Francois to reject claim 5 is, at worst, superfluous.

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regard as a new ground of rejection under 37 CFR § 41.50(b) to afford the appellants a fair opportunity to react thereto.

SUMMARY

The decision of the examiner to reject claims 2 through 18 is affirmed with respect to claims 5 through 7, 14/5, 15/5 and 16/5, and reversed with respect to claims 2 through 4, 8 through 13, 14/2, 15/2, 16/2, 17 and 18. In addition, the affirmance of the rejection of claims 5 through 7, 14/5, 15/5 and 16/5 constitutes a new ground of rejection under 37 CFR § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have

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the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART: 37 CFR § 41.50(b)

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

John P. McQuade
JOHN P. MCQUADE
Administrative Patent Judge

Jeffrey V. Nase
JEFFREY V. NASE
Administrative Patent Judge

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